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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,018	12/12/2001	Meric Adriansen	4408/23	4120

29858 7590 03/08/2007  
THELEN REID BROWN RAYSMAN & STEINER LLP  
900 THIRD AVENUE  
NEW YORK, NY 10022

EXAMINER
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RATHINASAMY, PALANI P

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/016,018	ADRIANSEN ET AL.	
	Examiner	Art Unit	
	Palani P. Rathinasamy	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-8, 15-26, 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Times Square Story II” (7/1/2000, hereinafter “Times Square”) in view of “General Cinema and Kodak Bring Digital Imaging to the Theater Lobby” (3/9/1998, hereinafter “Kodak”).**

3. Regarding claims 1, 19, and 37, applicant teaches a method entailing taking a picture of a person, inputting the picture into a system, superimposing the picture onto an advertisement, and displaying superimposed picture on a advertising display. Times Square teaches of a similar method whereby visitors use “Parting Shot”, a digital postcard station, and have their picture taken. (Times Square, Page 8, ¶ 4) Their face is then “superimposed on the Nasdaq video sign on Times Square.” (*Id.*) Times Square does not explicitly teach that the persons picture is superimposed onto an advertisement. Kodak’s “fantasy theater” allow “moviegoers to put themselves, their families and friends into pictures that can include movie content either as a border or background.” (Kodak, Page 2, ¶¶ 2-3) Kodak therefore teaches of superimposing people onto an advertisement of a movie.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to superimpose a person onto an advertisement and display it on a video sign. One would have been motivated to do this because Times Square teaches of using the Kodak "Fantasy Theatre" system. One of the features of the system is superimposing people onto an advertisement picture. Kodak teaches that this is done as an "effective advertising tool."

4. Regarding claim 2 and 20, applicant teaches of editing the picture to remove the background before superimposing. Times square does not explicitly teach of removing the background before superimposing. Kodak teaches that the people stand in front of a "green background screen" in order to have their picture superimposed onto a background of their selection. (Kodak, Page 2, ¶ 2) OFFICIAL NOTICE is taken that the green screen technology is old and well known and is used in order to remove the background when superimposing images.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use "green screen technology" to remove the background before superimposing the person onto the advertisement. One would have been motivated to do so in order to have a background of their own choosing.

5. Regarding claims 3 and 21, applicant teaches that the picture is taken in the vicinity of the advertising display. Times Square uses a kiosk for taking the photo. This kiosk is located in Times Square where the Nasdaq video sign is located. (Times Square, page 8)

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6. Regarding claims 4, 5, 22, and 23, applicant teaches that the picture is superimposed in a predetermined position on the advertising picture or video advertisement. OFFICIAL NOTICE is taken that green screen technology includes superimposing the picture onto a specific predetermined position in the background.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to superimpose the person onto a predetermined position on the background advertisement. One would have been motivated to do this because they would want the superimposed picture to be visually appealing.

7. Regarding claims 6 and 24, applicant teaches that the person can select from a library of advertisements. Kodak teaches of visitors being able to choose from "a number of backgrounds stored in computer memory." (Kodak, Page 2, ¶ 3)

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to allow the user to select from various backgrounds to superimpose their picture onto. One would have been motivated to do this in order to have more than one advertisement to entice visitors to use the system.

8. Regarding claims 7 and 25, applicant teaches that the picture of the person is edited so as to only include the head. Times Square teaches that "their faces [are] superimposed on the" screen. (Times Square, Page 8, ¶ 4)

9. Regarding claims 8 and 26, applicant teaches that the superimposed picture is made available to the person. Times Square does not explicitly teach of making the superimposed picture available to the person. Kodak teaches that the pictures are made available to the person on "stickers" at the kiosk. (Kodak, Page 2, ¶ 1)

Therefore, it would have been obvious to one of ordinary skill, at the time of the invention, to provide a physical form of the superimposed picture for the person to take. One would have been motivated to do in order to increase the effect of the advertising by providing a physical copy of the superimposed picture.

10. Regarding claims 15 and 33, applicant teaches of allowing the user to review the picture. Kodak teaches of showing the image on a monitor so that the user can preview the image. (Kodak, Page 2, ¶ 1)

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to allow the user to review the picture prior to superimposing it. One would have been motivated to do this in order to allow the user a chance to ensure that the picture looks proper.

11. Regarding claim 16-18, 34-36, applicant teaches of storing multiple images of people to create a composite. A composite of photographs is a slideshow. Applicant further teaches that this is done according to a predetermined schedule. OFFICIAL NOTICE is taken that slideshows are common methods for displaying photographs. They are done according to a predetermined schedule in order to allow the person to see their picture after an event has occurred. Examiner gives the example of "Tower of Terror" at Universal Studios Florida whereby a picture is captured when the person is on the ride. Upon leaving the ride, a slideshow is displayed that shows the pictures of the person and other people who were on the ride in a predetermined schedule. It is done so that the person can see their picture as they are exiting the ride. Examiner notes that this has been done since the late '90's. Therefore, it would have been obvious to

one of ordinary skill in the art, at the time of the invention, to create a composite of pictures and display them at a predetermined rate. One would have been motivated to do so because they would want the person at the kiosk to have time to get outside to view themselves on the video sign.

**12. Claims 9-14 and 27-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over “Times Square Story II” (7/1/2000, hereinafter “Times Square”) in view of “General Cinema and Kodak Bring Digital Imaging to the Theater Lobby” (3/9/1998, hereinafter “Kodak”) in view of Frey et al. (US 6,369,908 B1).**

13. Regarding claims 9, 10, 13, 14, 27, 28, 31, and 32, applicant teaches that the superimposed picture is available over the Internet and e-mail. Times Square teaches of a digital postcard station but does not explicitly teach of making the superimposed picture taken at the kiosk available over the Internet and e-mail. Frey et al. teaches of a photo kiosk that allows the user to take a photo, superimpose information onto the photo, and electronically receive the superimposed picture. (Abstract). Frey et al. teaches that the electronic receiving is done via the Internet and email. (Brief Summary of the Invention, Col 1, Lines 54-59).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide the person with the superimposed picture digitally over the Internet or e-mail. One would have been motivated to do this in order to have a digital copy of the superimposed picture.

14. Regarding claim 11 and 29, applicant teaches of obtaining and storing the users personal information. Frey et al. teaches of transmitting the superimposed picture via the Internet or email. It is inherent that this consists of obtaining the persons personal information (such as email address).

15. Regarding claims 12 and 30, applicant teaches of taking a picture of the advertising display and providing the person with a copy. Times Square teaches of a digital postcard station consisting of a person "having their faces superimposed on the Nasdaq video sign on Times Square." (Times Square, Page 8, ¶ 4) Times Square teaches that this is done so that people "get their picture on the largest video screen in Times Square." Therefore, the digital postcard is the person having their face on the Nasdaq screen. As stated in ¶ 9, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to take a photograph of this digital postcard and provide it to the person. One would have been motivated to do in order to increase the effect of the advertising by providing a copy of the superimposed picture.

16. **Claims 12-14 and 30-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Times Square Story II" (7/1/2000, hereinafter "Times Square") in view of "General Cinema and Kodak Bring Digital Imaging to the Theater Lobby" (3/9/1998, hereinafter "Kodak") in view of Frey et al. (US 6,369,908 B1) in view of Brennan (US 5,587,740).**

17. Regarding claims 12 and 30, applicant teaches of taking a picture of the advertising display and providing the person with a copy. Times Square teaches of a



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digital postcard station consisting of a person "having their faces superimposed on the Nasdaq video sign on Times Square." (Times Square, Page 8, ¶ 4) Brennan teaches of a digital photo kiosk whereby the kiosk will take photographs of people standing in front of interesting backgrounds. (Abstract). Brennan teaches that travelers take photos at scenic areas so that they have a "memory of the trip" as a photo of themselves at scenic locations. (Background of the Invention). It is well known that Times Square is a large tourist location. Tourists take photographs of the billboards, video displays, etc. as they are considered "scenic." Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have a device to take a photograph of the person displayed on the Nasdaq screen in Times Square and provide them with a copy. One would have been motivated to do so in order to provide the person with a "memory of the trip". In particular, a memory of "their picture on the largest video screen in Times Square." (Times Square, Page 8, ¶ 5).

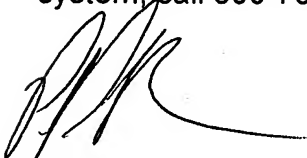
18. Regarding claims 13, 14, 31, and 32, applicant teaches that the superimposed picture is available over the Internet and e-mail. Times Square teaches of a digital postcard station but does not explicitly teach of making the superimposed picture taken at the kiosk available over the Internet and e-mail. Frey et al. teaches of a photo kiosk that allows the user to take a photo, superimpose information onto the photo, and electronically receive the superimposed picture. (Abstract). Frey et al. teaches that the electronic receiving is done via the Internet and email. (Brief Summary of the Invention, Col 1, Lines 54-59).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



PPR



Arthur Duran

Primary Examiner